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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

BADIO, B

ART UNIT

PAPER NUMBER

1616

13

DATE MAILED:

09/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/180,132

Applicant(s)

Kim et al.

Examiner

Barbara Badio

Group Art Unit

1616



☐ Responsive to communication(s) filed on _____.

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) 3, 8-14, 20-25, and 28-36 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 4-7, 15-19, 26, and 27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Final Office Action on the Merits

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. The rejection of claims 1, 2, 5-7 and 26-27 under 35 USC 112, second paragraph is withdrawn.

Claim Rejections - 35 USC § 102

3. The rejection of claims 1, 2, 6, 7, 26 and 27 under 35 USC 102(b) over Torelli et al. ('695) is withdrawn.

Claim Rejections - 35 USC § 103

4. The rejection of claims 1, 2, 5-7, 19 and 26-27 under 35 USC 103(a) over Torelli et al. ('695) is maintained.

Applicant argues that the reference does not teach or suggest the claimed compounds. According to applicant, the only compound disclosed by the reference that falls within the scope of the claim 1 as originally filed is compound 10 (found at cols. 15 and 16 of the reference) which is used in the present invention as an intermediate to

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form the other compounds of interest and said compound has been excluded from the amended claim 1. Applicant also argues that the reference does not provide motivation to make the instantly claimed compounds because one of the advantages of the claimed compounds is that they possess potent antiprogestational activity with minimal antigluocorticoid activity unlike the compounds of the reference. Therefore, if one of skill in the art were interested in making compounds that possess potent antiprogestational activity with minimal antigluocorticoid activity, the skilled artisan would stay away from the compounds and teachings of the reference. The argument was considered but not persuasive for the following reasons.

The issue of whether the compound exemplified by the prior art is used as an intermediate for the preparation other claimed compounds is not relevant because the compound was included in the genus recited by the originally filed claims. Once a compound is known in the art, the intended use disclosed by applicant or the prior art is irrelevant if said compound is claimed by an applicant.

Applicant also argues motivation to make the presently claimed compound(s). According to applicant, the reference does not provide motivation to make the instantly claimed compounds because one of the advantages of the claimed compounds is that they possess potent antiprogestational activity with minimal antigluocorticoid activity. It is noted that the prior art does not have to suggest the claimed compounds have the same or similar activity/utility as that discovered by applicant in order to support a legal

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conclusion of obviousness. In re Dillon, 919 F.2d 688, 696, USPQ 2d 1897, 1904 (Fed. Cir. 1990). An obviousness rejection is proper as long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation differs from that discovered by applicant. The motivation to make the instantly claimed compound is based on the teachings by the prior art of (1) an equivalence between several substituents, for example, an equivalence between hydroxy and acyloxy groups in the 17 α -position (see col. 3, lines 3-5) and (2) the antiprogestational and progestational properties of the prior art compound. Thus, it would have been obvious to the skilled artisan that modification of compound 10 found in cols. 15 and 16 by substituting an acyloxy group for the hydroxy group in the 17 α -position would result in a compound having similar activity as the genus taught by the reference. The ordinary artisan would be motivated to make additional compounds encompassed by the genus taught by Torelli et al. with the reasonable expectation that the compounds would be useful as taught by the reference.

For these reasons and those given in Paper No. 9, the rejection of claims 1, 2, 5-7, 19 and 26-27 under 35 USC 103(a) over Torelli et al. ('695) is maintained.

5. The rejection of claims 1, 2, 4-7, 15-19 and 26 under 35 USC 103(a) over Peeters ('787) is maintained.

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Applicant argues that the reference does not teach or suggest the claimed compounds. It is assumed applicant's argument is based on the fact that the reference does not exemplify any of the claimed compounds and not that the claimed compounds are not encompassed by the genus taught by the reference. Applicant also argues that the reference does not provide motivation to make the instantly claimed compounds because one of the advantages of the claimed compounds is that they possess potent antiprogestational activity with minimal antiglucocorticoid activity unlike the compounds of the reference which are disclosed as antiglucocorticoid steroids. Therefore, if one of skill in the art were interested in making compounds that possess potent antiprogestational activity with minimal antiglucocorticoid activity, the skilled artisan would stay away from the compounds and teachings of the reference. The argument was considered but not persuasive for the following reasons.

The issue is not whether the claimed compounds are exemplified by the prior art but whether they are made obvious based on the teachings of the prior art. The genus taught by the prior art encompasses the instantly claimed compounds. The reference also teaches a use for the compounds and thus, provides motivation to make any of the species taught by Peeters.

Applicant's argument that the reference does not provide motivation to make the instantly claimed compounds because one of the advantages of the claimed compounds is that they possess potent antiprogestational activity with minimal

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antiglucocorticoid activity is noted. However, the prior art does not have to suggest the claimed compounds have the same or similar activity/utility as that discovered by applicant in order to support a legal conclusion of obviousness. In re Dillon, 919 F.2d 688, 696, USPQ 2d 1897, 1904 (Fed. Cir. 1990). An obviousness rejection is proper as long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation differs from that discovered by applicant. The motivation to make additional compounds as taught by Peeters is based on the desire to make additional compounds useful in the treatment of anxiety as taught by the prior art.

For these reasons and those given in Paper No. 9, the rejection of claims 1, 2, 4-7, 15-19 and 26 under 35 USC 103(a) over Peeters ('787) is maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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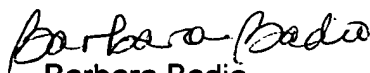
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry Contacts

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Badio whose telephone number is (703) 308-4595. The examiner can normally be reached between 7:30 am and 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


Barbara Badio
Primary Examiner
Art Unit 1616

August 30, 2000